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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097544,968	04/07/00	GRAY	L 12582

HM22/0508  
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EXAMINER  
COVINGTON, R

ART UNIT	PAPER NUMBER
1625	

DATE MAILED: 05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/544,968

Applicant(s)

Gray et al

Examiner

Covington

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 11/16/00
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-51 is/are pending in the application.
- Of the above claim(s) 17-39 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-16 and 40-51 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-51 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1612

1. Claims 1-51 are generic to a plurality of disclosed patentably distinct species compounds. Applicants are required under 35 U.S.C. § 121 to elect a single disclosed compound, even though this requirement is traversed. Applicant is advised that this requirement is not a restriction requirement, and is made for examination purposes only. Should the elected species be found allowable, the Examiner will continue the search to the extent necessary to determine the patentability of the generic claim.

Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

During a telephone conversation with Mr. Mark Cohen on March 23, 2001 an election of species was made to prosecute the invention of TH-77 shown on page 39 of the specification and exemplified by claim 11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-39 drawn to non-elected species are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 1612


2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.


3. Claims 1-16 and 40-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrand et al US 4,957,927 taken with Buzas et al US 4,908,365.

Ferrand et al US '929 teach diaryl methoxy alkyl-N-heterocyclic derivatives. See column 1 lines 10-20 patentees differ from the claimed invention in the cyclic linking group. However, Buzas et al US '365 teach analogous compounds having N-heterocyclic linking groups which correspond to that which is recited in the claims. See column 1 lines 15-25 and 50-60. To modify the prior art, Ferrand et al US '929, in light of the teachings of Buzas et al US '365 would have been obvious to one of ordinary skill as the results, enhanced sedative effect, would not have been unexpected.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Covington whose telephone number is (703)308-4704.

  
Covington/LR

March 27, 2001

  
ALAN L. ROTMAN  
PRIMARY EXAMINER